

Non-Fee Amendment

Applicant Docket No. 19001.1300

REMARKS

This paper is responsive to the Office Action mailed February 23, 2004. At the mailing of the Official Communication, claims 1-15 were pending. The Patent Office has set forth grounds for rejecting claims 1-15. The applicant submits that the claims are allowable in view of the art cited by the Patent Office and respectfully request the Patent Office remove the present rejection from these claims. The applicant's traversals of the Patent Office's rejections are provided below. The applicant also submits new claim 16 for the Office's consideration.

Rejection Under 35 U.S.C. §112 Rendered Moot

The Patent Office rejects claim 4 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Furthermore, the Patent Office rejects claims 4-6, 8 and 14 as having an insufficient antecedent basis for the corresponding limitations. Specifically, with regard to claims 4-6, and 8, the Patent Office states that "the search engine" lacks sufficient antecedent basis for this limitation. Without acquiescing to the merits of this rejection, claim 1 has been amended only to provide more specificity in the language of the claim. Therefore, the applicant respectfully submits that the rejection of claims 4-6, and 8 is rendered moot as claim 1 as originally presented and as amended presents sufficient antecedent basis for these claims as claims 4-6, and 8 depend directly from claim 1. Accordingly, Applicant respectfully requests that this rejection be withdrawn and these claims be allowed.

With regard to claim 6, the Office Action further states that the limitation "the web site"

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in line 2 lacks sufficient antecedent basis. The applicant has amended this claim to state "an internet site." Therefore, Applicant respectfully submits that the rejection of claims 6 is rendered moot. Accordingly, Applicant respectfully requests that this rejection be withdrawn and these claims be allowed.

Claims 1-6, 8, 10-13 and 15 Are Patentable Over the Cited Art

The Official Action sets forth rejections for claims 1-6, 8, 10-13 and 15 under 35 U.S.C. §103(a) alleging that the claims are unpatentable over U.S. Patent No. 6,523,037 B1 to *Monahan et al.* The applicant respectfully disagrees with this allegation.

Independent claim 1 recites "An interactive electronic commercial sent to a recipient as an attachment to an e-mail comprising: a commercial message portion that includes a first branding graphic; an interface portion that receives a search string designated by the recipient; a search engine interface; and a searching routine that submits the search string to a search engine via the search engine interface, and returns results to the recipient from within an e-mail client, without using a browser." Independent claim 15 recites "... the recipient opening the attachment; the opened attachment displaying an interface portion that receives a search string designated by the recipient; an e-mail client submitting the search string to a search engine; and returning a set of results from submission of the search string to the recipient from within the e-mail client, without using a browser." The present invention describes an interactive electronic commercial which is sent to a recipient via e-mail. The e-mail includes a branding graphic integrated with an interface portion through which the recipient may conduct an additional search. The Patent Office admits

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that *Monahan et al.* does not teach of a branding graphic in conjunction with an interface portion that receives a search string. The applicant respectfully submits that the *Monahan et al.* reference lacks more than this. In the present invention, the search interface may be customized according to the branding graphic so that suggested keywords may be presented to the recipient who may then make a selection (e.g. via a check box) or enter a new search string. The search result is then relayed back to the recipient within the e-mail, without the use of a browser. In one embodiment, the original e-mail could be updated on the fly as search results are generated. The entire process is conducted within the e-mail client and serves as an interactive electronic commercial without the use of a separate web browser. The recipient has full search capabilities within the email client.

Monahan et al. teaches a method for communicating search results between two entities over a communications network. An initial search result set is generated and sent to the first entity at which point a subset of this search result set is selected. This subset is then sent over the communications network to the second entity where a subset of this result set is selected. This process occurs in an iterative fashion which results in a continually narrowed subset of the original result set between the two or more entities. *Monahan et al.* teaches of the initial search being conducted by a search server. The initial search is conducted by inputting the search terms into a form communicated to the first user from a web site (Col. 5, lines 22-26). Col. 6, lines 25-31 of the *Monahan et al.* reference describes the use of the *Monahan et al.* method to "narrow the search result set of any of a number of online (or Internet-based) searches." Col. 5, lines 31-34 states that "... the web site utilizes the search servers to conduct a search ... to generate the

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result set of the data items.” The initial search routine does not take place within an e-mail client but rather, is conducted from an Internet site. While *Monahan et al.* does teach of one embodiment where the search result interface may be communicated to the recipient via an HTML-formatted e-mail message, the recipient is limited to selecting a subset of the search result sent which is presented in a condensed format (e.g. pre-defined template). The entities are then given the opportunity to only select a subset from the search result. This may be accomplished by presenting check boxes or radio buttons adjacent to each individual search result through which the entity makes selections. *Monahan et al.* does not describe, suggest or teach, nor would it be obvious from reading the *Monahan et al.* reference, the method of conducting the entire search process within an e-mail client where a branding graphic is integrated with a search interface.

Claims 2-6, 8, 10-13 depend either directly or indirectly from claim 1. Thus, since claim 1 is in condition for allowance, the dependent claims are also in condition for allowance as they include the limitations of the corresponding base claim.

The applicant greatly appreciates the Office’s careful consideration of these amendments and remarks. The applicant has thoroughly reviewed the references provided by the Office and has shown how the present invention is patentable over these references. Therefore, the applicant respectfully requests the Office to move this case towards allowance.

Claims 7, 9 and 14 Are Patentable Over the Cited Art

The Patent Office set forth rejections for claims 7, 9 and 14 under 35 USC §103(a)

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alleging that the claims are unpatentable over U.S. Patent No. 6,523,037 to *Monahan et al.* in view of U.S. Patent No. 6,101,485 to *Fortenberry et al.* The Patent Office further alleges that it would have been obvious to modify the teachings of *Monahan et al.* to include *Fortenberry et al.* in order to include the ability to order products from within an e-mail message as taught by *Fortenberry et al.*

Fortenberry et al. describes allowing a shopper to fill out and submit an order, directly from an e-mail solicitation. However, *Monahan et al.* and *Fortenberry et al.* do not teach of e-mails which contain a branding graphic integrated with an interface portion through which the recipient may conduct an additional search. Thus, combining the two references would only result in a means for a shopper to conduct orders by first narrowing the choices and then placing an actual order directly from the e-mail. There is no integrated search capability within the e-mail client and it would not have been obvious to add this element to the combination of *Monahan et al.* and *Fortenberry et al.* Therefore, the applicant respectfully submits that claims 7, 9 and 14 are allowable over the cited art. Furthermore, claims 7, 9 and 14 depend either directly or indirectly from claim 1 and thus are also in condition for allowance.

New claim 16 is similarly allowed over the cited art. Claim 16 recites that the commercial message is embedded within the email message. Thus, claim 16 is also in condition for allowance and the applicant greatly appreciates the Office's consideration.

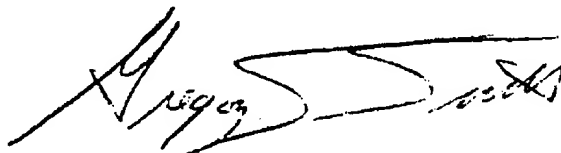
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CONCLUSION

Applicant respectfully submits the claims 1-16 are allowable over the cited art and respectfully request the Patent Office to move this case towards allowance. The applicant invites the Patent Office to contact the undersigned at its convenience should the Patent Office believe it would facilitate prosecution of this application. Applicant thanks the Examiner for consideration of this application.

Respectfully submitted,



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